UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,902	02/07/2001	Hidehiro Matsumoto	040425/0149	4766

			EXAMINER
22428	7590	05/18/2004	LASTRA, DANIEL

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ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/777,902	MATSUMOTO, HIDEHIRO
	Examiner	Art Unit	
	DANIEL LASTRA	3622	MU

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2004*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-23 and 25-38* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-9,11-23 and 25-38* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *8*.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-9, 11-23 and 25-38 have been examined. Application 09/777,902

(INFORMATION COMMUNICATION SYSTEM, INFORMATION COMMUNICATION

METHOD, AND INFORMATION PROVISION BUSINESS METHOD) has a filing date

02/07/01 and a foreign priority 2000-031346 (02/09/2000).

Response to Amendment

2.   In response of Office Action dated 02/23/04, the Applicant amended claims 1, 15,

29, cancel claims 10, 24 and added claims 33-38.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

Claims 1-9, 11-23, 25-35 and 37 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Herz (U.S. 6,029,195) in view of Uemura et al (6,430,161).

As per claim 1, Herz teaches:

An information communication system in which a service information provider

registers in advance service information in information provision means, managed by a

carrier, for providing the service information, and a user receives the service information

by accessing the information provision means via a communication network, comprising:

a database for separately storing profile information indicating attribute information of the user and preference information indicating a preference and taste of the user upon encrypting the profile information and preference information (see column 5, lines 5-67; column 40, lines 19-33; column 41, lines 14-21; column 44, lines 1-39).

Herz fails to teach:

wherein said storage means acquires and stores terminal attribute information of the user and communication attribute information required to access said information provision means as the profile information. However, Uemura teaches a system that acquires and stores users' terminals attributes information in users' profiles (see column 3, lines 37-65; column 4, lines 53-62; column 5, lines 46-53; column 7, lines 1-30; column 8, lines 29-55; column 9, lines 1-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would store terminal and communication attributes in the users' profiles, as taught by Uemura. This feature would help the Herz system to better target advertisements and information to users because Herz would dynamically collect information about the users' terminals from the users' profiles and would automatically select the amount and type of data that would be transmitted to the users (see Uemura column 9, lines 1-20). This feature would save time and money, as there is no purpose of transmitting information to users that would not be able to view it because their users' terminals would not be able to display the information.

As per claim 2, Herz teaches:

A system according to claim 1, wherein the profile information and preference information are pieces of information for which the user gave consent to disclosure (see column 5, lines 36-40).

As per claim 3, Herz teaches:

A system according to claim 1, further comprising means for generating a keyword for searching/ extracting information stored in said database on the service information provider side (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 4, Herz teaches:

A system according to claim 2, further comprising means for generating a keyword for searching/ extracting information stored in said database on the service information provider side (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 5, Herz teaches:

A system according to claim 3, further comprising information search means for searching said database to extract information in accordance with the keyword and supplying the extracted information to the service information provider (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 6, Herz teaches:

A system according to claim 4, further comprising information search means for searching said database to extract information in accordance with the keyword and supplying the extracted information to the service information provider (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24).

As per claim 7, Herz teaches:

A system according to claim 5, wherein said information search means also supplies key information required to decrypt the extracted information (see column 93, lines 9-13).

As per claim 8, Herz teaches:

A system according to claim 6, wherein said information search means also supplies key information required to decrypt the extracted information (see column 93, lines 9-13).

As per claim 9, A system according to claim 1, further comprising storage means for, when the user accesses said information provision means, obtaining the profile information and preference information in accordance with contents of the access to said information provision means, and storing the profile information and preference information in said database (see column 5, lines 5-67; column 40, lines 19-33; column 41, lines 14-21; column 44, lines 1-39).

As per claim 11, Herz teaches:

A system according to claim 9, wherein said storage means acquires and stores the preference information on the basis of link information obtained when the user

sequentially selects menu items on a display screen in accessing said information provision means (see column 6, lines 16-43; column 8, lines 1-21).

As per claim 12, Herz teaches:

A system according to claim 9, wherein said storage means acquires and stores a filter condition as the preference information which is set when the user receives information from said information provision means and indicates necessity/non-necessity of information (see column 18, lines 10-30).

As per claim 13, Herz teaches:

A system according to claim 9, wherein said storage means acquires and stores positional information and a type of communication line, as the preference information, when the user is accessing (see column 94, lines 48-67; column 95, lines 56-60).

As per claim 14, Herz teaches:

A system according to claim 9, wherein said storage means acquires and stores as the preference information a use frequency of an access device through which the user is accessing (see column 57, lines 55-67).

Claim 15 contains the same limitation as claim 1 therefore the same rejection is applied.

Claim 16 contains the same limitation as claim 2 therefore the same rejection is applied.

Claim 17 contains the same limitation as claim 3 therefore the same rejection is applied.

Claim 18 contains the same limitation as claim 4 therefore the same rejection is applied.

Claim 19 contains the same limitation as claim 5 therefore the same rejection is applied.

Claim 20 contains the same limitation as claim 6 therefore the same rejection is applied.

Claim 21 contains the same limitation as claim 7 therefore the same rejection is applied.

Claim 22 contains the same limitation as claim 8 therefore the same rejection is applied.

Claim 23 contains the same limitation as claim 9 therefore the same rejection is applied.

Claim 25 contains the same limitation as claim 11 therefore the same rejection is applied.

Claim 26 contains the same limitation as claim 12 therefore the same rejection is applied.

Claim 27 contains the same limitation as claim 13 therefore the same rejection is applied.

Claim 28 contains the same limitation as claim 14 therefore the same rejection is applied.

As per claim 29, Herz teaches:

An information communication system in which a service information provider registers in advance service information in information provision means, managed by a carrier, for providing the service information provision means via a communication

network, an information communication business method which uses a database in which profile information indicating attribute information of the user and preference information indicating a preference and taste of the user are stored after the profile information and preference information are encrypted and provides the stored information to the service information provider with a charge, comprising the steps of:

generating a keyword which is used by the service information provider to search the database (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24);

searching the database in accordance with the keyword, extracting information, and providing the extracted information to the service information provider (see column 5, lines 5-65; column 6, lines 16-59; column 7, lines 1-16; column 2, lines 39-65; column 63, lines 9-24);

Herz fails to teach:

providing first specific information to the user based on first profile information of the user that indicates a first type of terminal used by the user to access said information provision means; and

providing second specific information to the user based on second profile information of the user that indicates a second type of terminal used by the user to access said information provision means;

wherein the first specific information is different from the second specific information.

However, Uemura teaches a system that stores users' terminals attributes information in users' profiles and calculates dynamically the type and amount of data that the users' terminals would be able to receive and display (see column 3, lines 35-65; figures 2, 3; column 3, lines 37-65; column 4, lines 53-62; column 5, lines 46-53; column 7, lines 1-30; column 8, lines 29-55; column 9, lines 1-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Herz system, previous of transmitting any data, would determine the type of terminal that would receive the data and would dynamically adjust the type and amount of the data that would be transmitted to the terminal, as taught by Uemura. This feature would save time and money, as there is no purpose of transmitting information to users that would not be able to view it because their users' terminals would not be able to display the information.

As per claim 30, Herz teaches:

A system according to claim 29, wherein the profile information and preference information are pieces of information for which the user gave consent to disclosure (see column 5, lines 36-40).

As per claim 31, Herz teaches:

A system according to claim 29, further comprising providing key information for decrypting the extracted information when the extracted information is provided to the service information provider (see column 93, lines 9-13).

Claim 32 contains the same limitation as claim 31 therefore the same rejection is applied.

As per claim 33, A system according to claim 1, contains the same limitations as claim 29 therefore the same rejection is applied.

Claim 34, a method according to claim 15, contains the same limitations as claim 33 therefore the same rejection is applied.

As per claim 35, Herz teaches:

A system according to claim 1, further comprising:

means for preferentially displaying first specific information to the user on a display when the user accesses the information provision means, the first specific information corresponding to previous selections made by the user when the user accessed the information provision means (see column 1, lines 16-42).

As per claim 37, A method according to claim 15 contains the same limitations as claim 35 therefore the same rejection is applied.

Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (U.S. 6,029,195) in view of Uemura et al (6,430,161) and further in view of Crawford (U.S. 6,327,579).

As per claim 36, Herz fails to teach:

A system according to claim 33, wherein the first type of terminal is a telephone and the second type of terminal is a personal computer, and wherein the request for information by the user via the telephone automatically causes the information to be downloaded to the personal computer of the user. However, Crawford teaches in column 2, lines 12-17 that "these information providers automatically answer telephone calls placed by user's computers, automatically respond to information requests, and

provide the information over the telephone line to the calling computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Herz system would receive users' telephone requests for obtaining information or data, as taught by Crawford and previous to transmitting any data or information, Herz would determine the type of terminal that would receive the data, such as a personal computer and would dynamically adjust the amount and type of the data that would be transmitted to the users' terminals, as taught by Uemura. This feature would save time and money, as there is no purpose of transmitting information to users that would not be able to view it because their users' terminals would not be able to display the information.

As per claim 38, A system according to claim 34 contains the same limitations as claim 36 therefore the same rejection is applied.

Response to Arguments

4.   Applicant's arguments with respect to the rejection(s)of claim(s) 1 and 15 under Herz have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Uemura et al.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Daniel Lastra

May 4, 2004

JAMES W. MYHRE
PRIMARY EXAMINER